



1425  
**RECEIVED**  
OCT 29 2003  
TECH CENTER 1600/2900

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of: **KAWAHARA, Yasuyuki et al.**

Serial No.: **10/019,287**

Group Art Unit: **1764**

Filed: **January 2, 2002**

Examiner: **Taylor V. OH**

P.T.O. Confirmation No.: **1458**

For: **DICARBOXYLIC DIESTER, PROCESS FOR PRODUCING THE SAME, AND REFRIGERATING MACHINE LUBRICATING OIL COMPRISING THE ESTER**

**RESPONSE TO THE RESTRICTION REQUIREMENT**  
**DATED September 24, 2003**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Date: October 24, 2003

Sir:

This paper is submitted in response to the Official Action dated **September 24, 2003**.

In the Action, restriction is required between Group (I), Claims 1-5, 14-16, and 18; and Group (II), Claims 12-13 and 31-33; and Group (III), Claims 6-11 and 19-30.

Applicants hereby elect the subject matter of Group (III), Claims 6-11 and 19-30 for prosecution in this application. This election is made with traverse, for the following reasons:

1. Unity of invention was recognized in the IPE report, therefore PCT Rule 13.1 was met.
2. Technically, the process (Group III claims) inherently results in the claimed ester compounds (Group I claims) which are now the state of the art in refrigerating oils (Group II claims), because old refrigerating oils containing CFC's have been banned (see enclosed article). The special technical feature is of course the ester compounds of the generic formula

(E) recited generally and specifically in all groups of claims.

3. Because all groups should be examined together and undue diverse searching (only searching for formula (E)) should not be required, it is requested that the election requirement be withdrawn.

The process of Group III inherently results in the compounds of Group I because the process of Group III is limited by formulas (1-3) in independent claim 6 and formulas (4, 4a, 5, 5s, 7 and 8) in independent claim 19. These are the same formulas of the Group I compounds recited in independent claims 1-3 and 14. The special technical feature is of course the ester compounds described by the chemical formulas.

Furthermore, the enclosed article states the current art of refrigerant oils are HFC refrigerant oils because CFC oils have been banned because they are harmful to the environment. In addition the specification on p.2-4 describes that oxygen-containing synthetic oils, such as polyol esters and polyalkylene glycols have come to be used for refrigerator oils.

The result is a complete shift in refrigerator oil technology, making the ester compounds of Group I, one and the same with refrigerator oils (Group II ) that contain the compounds. The realization of the harmfulness of CFC's and HCFC's caused this complete shift in technology as explained on p.875 of the attached article.

U.S. Patent Application No. 10/019,287  
Reply to Restriction Requirement of September 24, 2003

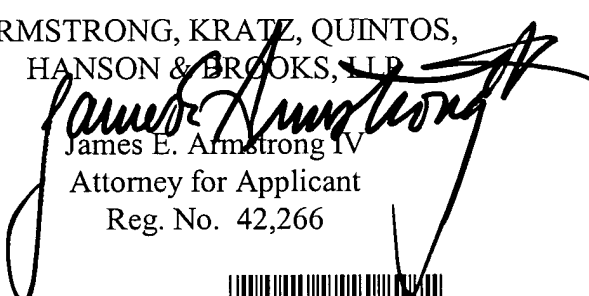
Because the applicants have proven unity of invention consistent with the IPE report recognition of unity of invention, the applicants respectfully request that all claims 1-33 be examined in the same application.

In the event that this paper is not timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 01-2340.

In the event any additional fees are required in connection with this response, please charge our Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS,  
HANSON & BROOKS, LLP

  
James E. Armstrong IV  
Attorney for Applicant  
Reg. No. 42,266

JAM/xl  
Atty. Docket No. 011731  
Suite 1000  
1725 K Street, N.W.  
Washington, D.C. 20006  
(202) 659-2930



23850

PATENT TRADEMARK OFFICE